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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,673	03/16/1999	TAKAHISA UEDA		2804

7590 12/19/2003

FELIX J D'AMBROSIO  
JONES TULLAR & COOPER  
P O BOX 2266 EADS STATION  
ARLINGTON, VA 22202

EXAMINER
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MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/270,673

Applicant(s)

UEDA ET AL.4

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) 34-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 10/3/03 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/270,673 is acceptable and a CPA has been established. An action on the CPA follows. Application No. 09/270,673 was abandoned on 9/27/02, however, applicant has now filed a CPA which has been entered. Since there is no amendment the official office action of paper #8 is repeated and set forth below for applicant's convenience. Furthermore the arguments from Advisory Actions, papers 11 and 13 are repeated and provided below for applicant's convenience. The instant action is not made final as to give applicant a chance to respond after revival of an abandonment.

### ***Election/Restrictions***

2. Newly submitted claims 34-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly added claims 34-42 are substantially identical to originally filed claims 13-21 both the newly added claims and originally filed claims being drawn to a method of producing an annular sliding fluoroplastics member.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-42 are withdrawn from consideration

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as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. This application contains claims 34-42 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### **REJECTIONS REPEATED**

4. There are no rejections repeated since applicant has canceled all of the originally filed claims via paper #7.

### **REJECTIONS WITHDRAWN**

5. All of the prior art rejections of record in paper #5, pages 2-7, paragraphs 3-8 have been withdrawn since applicant has canceled all of the originally filed claims.

### **NEW REJECTIONS**

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 22-24, 26-27 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Braus et al. (U.S. Patent No. 4,847,135) in view of Hartel et al. (U.S. Patent No. 4,942,075).

Claims 22-24, 26-27 and 33 are rejected for the same reasons of record as originally filed claims 1-3, 5-6 and 12 since claims 22-24, 26-27 and 33 are substantially identical to originally filed claims 1-3, 5-6 and 12 which were rejected in paper #5, pages 3-4, paragraph 4.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braus et al. (U.S. Patent No. 4,847,135) in view of Hartel et al. (U.S. Patent No. 4,942,075), as applied to claims 22-24, 26-27 and 33 above, and further in view of Stiff et al. (U.S. Patent No. 3,675,980).

Claim 25 is rejected for the same reasons of record as originally filed claim 4 since claim 25 is substantially identical to originally filed claim 4 which was rejected in paper #5, page 4, paragraph 5.

9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braus et al. (U.S. Patent No. 4,847,135) in view of Hartel et al. (U.S. Patent No. 4,942,075), as applied to claims 22-24, 26-27 and 33 above, and further in view of Runton et al. (U.S. Patent No. 3,000,076).

Claims 28-29 are rejected for the same reasons of record as originally filed claims 7-8 since claims 28-29 are substantially identical to originally filed claims 7-8 which were rejected in paper #5, pages 5-6, paragraph 6.

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10. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braus et al. (U.S. Patent No. 4,847,135) in view of Hartel et al. (U.S. Patent No. 4,942,075), as applied to claims 22-24, 26-27 and 33 above, and further in view of Board, Jr. (U.S. Patent No. 3,950,599).

Claims 30-31 are rejected for the same reasons of record as originally filed claims 9-10 since claims 30-31 are substantially identical to originally filed claims 9-10 which were rejected in paper #5, pages 6-7, paragraph 7.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braus et al. (U.S. Patent No. 4,847,135) in view of Hartel et al. (U.S. Patent No. 4,942,075) and Board, Jr. (U.S. Patent No. 3,950,599), as applied to claims 30-31 above, and further in view of Sumiyoshi et al. (U.S. Patent No. 4,559,248).

Claim 32 is rejected for the same reasons of record as originally filed claim 11 since claim 32 is substantially identical to originally filed claim 11 which was rejected in paper #5, page 7, paragraph 8.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

12. *(Response to arguments from paper #8)* Applicant's arguments filed 7/31/01 have been fully considered but they are not persuasive. Applicant has argued that Braus does not disclose an orientation for the short fibers. Applicant's argument has merit, however, the rejection is based upon the combined teachings of Braus and Hartel and Braus does specifically disclose a composition material including fluororesin and aramide short fibers. Hartel at the very least teaches orientation of aramide fibers in

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matrix materials for the purpose improved load strength (see column 3, lines 25-40, column 2, lines 23-27). Applicant has argued that Hartel teaches the orientation of long fibers as opposed to short fibers. In fact, this is not the case, Hartel never actually spells out whether the fibers are long or short. However, it is the opinion of the examiner that upon inspection of Figs. 1 and 3 one of ordinary skill in the art can see that the fibers are short fibers. Moreover, even assuming, for the sake of argument, that Hartel teaches long fibers, the combined teachings of Braus and Hartel clearly suggest applicant's invention since both references are directed towards aramid fibers in matrix materials, same field of endeavor, and Hartel teaches orientation of aramide fibers in matrix materials for the purpose improved load strength as described above.

13. *(Response to arguments from paper #11)* Applicant's arguments filed 1/18/02 have been carefully considered but are deemed unpersuasive.

Applicant has argued that there is simply no way of knowing whether the fibers disclosed in Hartel et al. are long or short. Applicant's argument may have merit. However, Braus et al. clearly disclose short fibers (see column 4, lines 3-15).

Applicant has argued that the limitation, "...20 or more wt% of short fibers...are oriented in a direction along which the magnitude of a load is large..." is not taught by the references. However, Hartel et al. specifically teach that all of the fibers are oriented (see column 3, lines 29-36). Moreover, this limitation was addressed in paper #5, page 3, paragraph 4 and paper #9, pages 3-4, paragraphs 6-10. While applicant may argue that Hartel et al. do not teach a specific weight percentage of the

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fibers with the specific orientations recited in applicant's claims, such a weight percentage is mere optimization of a result effective variable *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Applicant has also argued that the fact that both Braus et al. and Hartel et al. are directed toward aramid fibers in matrix materials, same field of endeavor, cannot stand as the basis for rejection. Applicant's argument has some merit. However, the basis for the rejection is that the combined teachings of Braus et al. and Hartel et al. obviate applicant's invention as claimed and that one of ordinary skill in the art would have been motivated to combine the references in order to provide improved load strength.

14. (*Response to arguments from paper #13*) Applicant's arguments filed 03/19/02 have been carefully considered but are deemed unpersuasive.

Applicant has argued that there is simply no way of knowing whether the fibers disclosed in Hartel et al. are long or short. Applicant's argument may have merit. However, Braus et al. clearly disclose short fibers (see column 4, lines 3-15).

Applicant has argued that the limitation, "...20 or more wt% of short fibers... are oriented in a direction along which the magnitude of a load is large..." is not taught by the references. However, Hartel et al. specifically teach that all of the fibers are oriented (see column 3, lines 29-36). Moreover, this limitation was addressed in paper #5, page 3, paragraph 4 and paper #9, pages 3-4, paragraphs 6-10. While applicant may argue that Hartel et al. do not teach a specific weight percentage of the fibers with the specific orientations recited in applicant's claims, Braus et al. teach the aramid fibers



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(column 4, lines 3-15) and that the aramid fibers are present in a matrix from 1.5 to 35% by volume (column 4, lines 3-15). Thus one of ordinary skill in the art would have recognized that the weight percent would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made a composite material with applicant's claimed weight percent for aramid fibers in order to provide improved mechanical properties, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Applicant has also argued that the fact that both Braus et al. and Hartel et al. are directed toward aramid fibers in matrix materials, same field of endeavor, cannot stand as the basis for rejection. However, the basis for the rejection is that the combined teachings of Braus et al. and Hartel et al. obviate applicant's invention as claimed, as discussed in paper #8, pages 3-4, paragraphs 5-10, and that one of ordinary skill in the art would have been motivated to combine the references in order to provide improved load strength.

### **Conclusion**

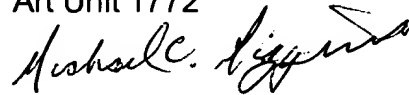
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael C. Miggins  
Examiner  
Art Unit 1772



MCM  
October 20, 2003